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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,727	09/19/2003	Cesar C. Carriazo	C259 1010.1	6051

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08/19/2004

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EXAMINER

JACKSON, SUZETTE JAMIE

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 08/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/666,727

Applicant(s)

CARRIAZO, CESAR C.

Examiner

Suzette J Jackson

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-11,16,17,22 and 23 is/are rejected.
- 7) ☒ Claim(s) 3,4,12-15 and 18-21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/19/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Oath/Declaration***

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02. The oath or declaration is defective because: It has not been signed by the inventor(s)

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 1 recites the limitation "further comprising" in line 5. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-2, 5-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Brito Muguerza FR2696340. Brito Muguerza discloses the invention as *currently claimed* comprising: An implant *for altering the iris color*, consisting of a completely or partially transparent, semi-transparent or non-transparent, colored biocompatible and flexible material (3) (see page 1, lines 31-33 for plastic PMMA and page 2, lines 1-6 for silicone properties); where in the implant is annular *thereby forming an annular area coming to rest on the iris of an eye*, and wherein the implant further comprises a central circular opening (4) and at least one attaching means (5) disposed with the annular area. It is inherent that the annular area can consist of the edges of the device as well any surface that is *within the area*. The intended use recitation/functional language of the claims carries no patentable weight in the absence of any distinguishing structure. Brito Muguerza clearly discloses the structure as claimed and is found to be inherently capable of performing the function; wherein the attaching means consist of at least one opening in the annular area (11); wherein the attaching means consists of at least one hook like protrusion or projection (5).

Art Unit: 3738

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 16-17 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brito Muguerza FR2696340 in view of Terry et al. 6,280,469. Brito Muguerza FR2696340 has been disclosed above however Brito Muguerza FR2696340 does not specify the method of making a small cut in the eye. Terry et al. teaches that lenses can be inserted by making a small incision into the eye for the introduction of a lens (see col. 5, lines 37-51). It would have been obvious to one having ordinary skill in the art at the time the invention was made to take the lens device of Brito Muguerza (which structure has been disclosed above) and insert it into the eye by making a small cut/incision because it would provide for a less invasive means for delivery and because the material of Brito Muguerza is a soft flexible plastic the device is capable of being fold for incision into the small incision. It is also obvious that the eye is first prepared to receive the IOL as it is inherent that the patient will close the eye after the procedure to moisten the eye tissue.

Art Unit: 3738

***Allowable Subject Matter***

9. Claims 3-4, 12-15, 18-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Klima 6,654,3453; Sigoloff 6,149,685; Kahn 2004/0153148 and Kelman 2004/0006387 all show related material.

11. examiner should be directed to Suzette J. Jackson whose work schedule is Monday-Friday 9-6:30 off every other Friday and whose telephone number is 703-308-6516.

12. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306.

13. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



Suzette J. Jackson  
18 August 2004